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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,210	01/04/2002	Rohan Coelho	42390P11779	2041

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EXAMINER	
HARBECK, TIMOTHY M	
ART UNIT	**PAPER NUMBER**
3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/039,210	COELHO, ROHAN	
	Examiner	Art Unit	
	Timothy M. Harbeck	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/29/2006*, 10/30/2006
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenblum (US 6,529,801 B1).

Re Claim 1: Rosenblum discloses a method of transacting a prescription, the method comprising:

- Receiving a prescription proposal from a portable healthcare device for real time adjudication (Column 8, lines 8-11)
- Transmitting the prescription proposal to a benefits manager for immediate adjudication of the prescription proposal (Column 8, lines 12-18)
- Preparing the results of the adjudication from the benefits manager for reading at the portable healthcare device (Column 8, lines 18-21)
- Forwarding the prepared results to the portable healthcare device to be considered in generating a prescription (Column 8, lines 18-21 and Column 9 line 19-24) in real-time across a network pathway to a remote

prescription site (Column 9 lines 56-62); Also see FIG 3 for the discloses steps

- Comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results (Column 9, lines 19-40)

Re Claim 2: Rosenblum discloses the claimed method supra and further discloses the step further including receiving the prescription from the portable healthcare device (Column 8, lines 8-11) and transferring the prescription across the network pathway to the remote prescription site (Column 9, lines 56-62).

Re Claim 3: Rosenblum discloses the claimed method supra and further discloses processing the prescription according to at least one rule prior to transferring of the prescription (Column 9, lines 19-27)

Re Claim 4: Rosenblum discloses the claimed method supra and further discloses determining an appropriate benefits manager to adjudicate the prescription proposal (Column 7, lines 35-40 and Column 8, lines 12-18) and the transmitting of the prescription proposal occurs if an appropriate benefits manager is identified (Column 8, lines 16-18)

Re Claim 5: Rosenblum discloses the claimed method supra and further discloses wherein the adjudication results indicate an acceptance or decline of the prescription proposal (Column 8, lines 18-21; See FIG 6)

Re Claim 6: Rosenblum discloses the claimed method supra and further discloses wherein the adjudication results includes at least one suggested alternative

parameter (Column 10, lines 2-7 "modify the transaction to permit re-adjudication; Also see Fig 6)

Re Claim 7: Rosenblum discloses the claimed method supra and further discloses wherein the suggested alterative parameter addresses an adverse drug interaction (Column 9, lines 36-40), compliance with formulary (Column 9, lines 19-27) or patient cost.

Re Claim 8: Rosenblum discloses the claimed method supra and further discloses wherein the prescription includes at least one of the suggested alternative parameters (Column 9, lines 24-27)

Re Claim 9: Rosenblum discloses the claimed method supra and further discloses wherein the adjudication includes consideration of patient eligibility, drug interaction (Column 9, lines 36-40), formulary compliance (Column 9, lines 19-27) or patient healthcare history.

Re Claim 26: Rosenblum discloses a method of verifying a user in a prescription related transaction the method comprising:

- Receiving a prescription proposal from a portable healthcare device for real time adjudication (Column 8, lines 8-11)
- Determining an appropriate benefits manager to adjudicate the prescription proposal (Column 7, lines 35-40) and;
- If an appropriate benefits manager is identified (Column 8, lines 12-21)

- Transmitting the prescription proposal to a benefits manager for immediate adjudication of the prescription proposal (Column 8, lines 12-18)
- Preparing the results of the adjudication from the benefits manager for reading at the portable healthcare device (Column 8, lines 18-21)
- Forwarding the prepared results to the portable healthcare device to be considered in generating a prescription (Column 8, lines 18-21 and Column 9 line 19-24) in real-time across a network pathway to a remote prescription site (Column 9 lines 56-62); Also see FIG 3 for the discloses steps
- Receiving the prescription from the portable healthcare device (Column 8, lines 8-11) and transferring the prescription across the network pathway to the remote prescription site (Column 9, lines 56-62)
- Comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results (Column 9, lines 19-40)

Re Claim 27: Rosenblum discloses the claimed method supra and further discloses wherein the adjudication results includes at least one suggested alternative parameter (Column 10, lines 2-7 "modify the transaction to permit re-adjudication; Also see Fig 6).

Re Claim 28: Rosenblum discloses the claimed method supra and further discloses wherein the prescription includes at least one of the suggested alternative parameters (Column 9, lines 24-27)

Re Claim 29: Rosenblum discloses the claimed method supra and further discloses wherein the adjudication includes consideration of patient eligibility, drug interaction (Column 9, lines 36-40), formulary compliance (Column 9, lines 19-27) or patient healthcare history

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenblum.

Re Claims 10-16: Further system claims would have been obvious in order to implement the previously rejected method claims 1-3 and 5-8 respectively and are therefore rejected using the same art and rationale.

Re Claims 17-25: Further computer readable medium claims would have been obvious in order to implement the previously rejected method claims 1-9 respectively and are therefore rejected using the same art and rationale.

Response to Arguments

Applicant's arguments filed 08/04/2006 have been fully considered but they are not persuasive.

Applicant has added limitations to the independent claims and argues that the prior art reference cited in the last Office Action does not disclose these limitations. The examiner disagrees. Specifically the applicant argues that Rosenblum does not teach the step of "comparing the prescription with the prepared results to determine whether the prescription is in compliance with the prepared results." However in the Rosenblum disclosure, it is explicitly taught that a prescriber, presumably a doctor, examines a patient, writes a prescription, and communicates with the patients insurance information to determine the approval status of said prescription (Column 9, lines 10-24). In addition to this, doctor utilizing the handheld device is able to compare his prescription with the patient's insurance plan (prepared results) to see if it is a valid option, and if it is not the prescriber is "prompted to a drug of the same therapeutic class that is covered by the patient's insurer's formulary (Column 9, lines 19-27)." It appears clear that Rosenblum does in fact compare an original prescription with the prepared results of the insurer to determine compliance. Therefore the rejection is maintained.

Similar arguments and amendments have been presented for each of the independent claims, and therefore the examiner relies on similar arguments as well in maintaining those rejections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER

SUPERVISORY PATENT EXAMINER